

REMARKS/ARGUMENTS

The Final Office Action mailed May 19, 2006, has been carefully reviewed and this paper and RCE are Applicant's response thereto. Claims 1-33 are pending. Claims 1-2, 4-5, 8-15, 20-22 and 29-33 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,250,720 to Entrop *et al.* (Entrop). Claims 23-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Entrop in view of U.S. Patent No. 5,743,627 to Casteel (Casteel). Claims 3, 6-7, 10, 16 and 18-19 were rejected under 35 U.S.C. § 102(a) as being unpatentable over Entrop in view of U.S. Patent No. 4,516,197 to Yonkers *et al.* (Yonkers). In response, Applicant respectfully traverses the rejections in view of the above amendments and the remarks that follow.

Amendments to the Claims

Applicant appreciates the notification of informalities in the claims and has amended claims 1, 20 and 23 to correct the noted informalities.

Claim 15 has been amended to improve clarity by removing a second recitation of the center, however, no change in the scope was believed made. Thus, no new matter was added.

Claim 29 was amended to clarify the intended scope and now recites "using a light shield including a center and an outer edge, the light shield including at least three equally sized coverage areas between the center and the outer edge to decreasingly shield a percentage of the light source along a path from the center to the outer edge, wherein each of the coverage areas shields a different percentage of light." Support for this amendment is at least found in Figure 8, thus no new matter has been added.

Rejection under 35 U.S.C. § 102(b) - Entrop

Claims 1-2, 4-5, 8-15, 20-22 and 29-33 were rejected under 35 U.S.C. § 102(b) as being anticipated by Entrop. Claims 1, 20 and 29 are independent.

Regarding independent claim 1, the Advisory Action, pg. 2, admits that "Entrop fails to show a plurality of coverage zones wherein each coverage zone has a light blocking area ... wherein the areas decreasing block light along the first path." Thus, it is unclear how Entrop can be said to disclose all the features of claim 1. As Entrop fails to disclose all the features of claim

1, claim 1 cannot be considered anticipated. To the extent the Examiner disagrees, additional arguments regarding the dependent claims are provided below.

Claims 2, 4-5, and 8-15 depend from claim 1 and are not anticipated for at least the above reasons and the additional features recited therein. For example, if the Office Action is suggesting that reflector 7 and reflector 6 are being read as the light shield then plainly the abrupt change in the amount of light blocking area of what the Office Action is reading as the light shield fails to disclose “wherein the decrease in the light blocking area is linear along the first and second paths” as recited in claim 2. In addition, claim 5 recites “wherein the light shield comprises an inner aperture on the first side” and the combination of reflector 6 and 7 fails to disclose this and at most discloses an outer aperture. Furthermore, claim 14 recites “wherein the outer aperture comprises a generally saw-tooth pattern” and the combination of the reflector 6, 7 fails to disclose this (as appears to be admitted). Claim 15 recite “wherein a measurable coverage area at the center is less than 90 percent” and plainly the coverage area of reflector 7 is a hundred percent (as admitted in the Final Office Action) thus Entrop fails to disclose this feature.

Regarding independent claim 20, as previously noted, Entrop completely fails to disclose the feature of “a light shield mounted to the fixture ... wherein a percentage of light from the light source can pass through the light shield at the center” as recited in claim 20. As previously explained, in an embodiment of the light shield may include apertures that allow light to pass through the center of the light shield. Thus, the Final Office Action’s reasoning on pg. 8-9 does not appear to be supported. Thus, Entrop cannot be said to disclose this feature and therefore Entrop fails to anticipate claim 20.

Claims 21-22 depend from claim 20 and are allowable for the reasons discussed above and for the additional features recited therein.

Regarding independent claim 29, it now recites “using a light shield including a center and an outer edge, the light shield including at least three equally sized coverage areas between the center and the outer edge to decreasingly shield a percentage of the light source along a path from the center to the outer edge, wherein each of the coverage areas shields a different percentage of light.” While not agreeing with the Final Office Action’s position, plainly Entrop fails to show a light shield that can be divided into three equally sized coverage areas that each

shields a different percentage of light. Thus, Entrop cannot be said to disclose all the features of claim 29 and therefore claim 29 is not anticipated by Entrop.

Claims 30-33 depend from claim 29 and are not anticipated for at least the reasons discussed above and for the additional features recited therein. For example, claim 30 recites “wherein the step of the using the light shield provides a linear change in the percentage of shielding along the path” and at most Entrop can be read to disclose providing a linear change in the amount of light emitted.

Rejection under 35 U.S.C. § 103(a) – Entrop and Casteel

Claims 23-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Entrop in view of Casteel. The Final Office Action has admitted that Entrop does not disclose the claimed feature of a maximum thickness of 1.5 inches but suggests that Casteel teaches this and it would have been obvious to modify Entrop in view of Casteel to reach the recited feature. However, as previously noted, Casteel only discloses a minimum thickness of 1.7 inches and thus fails to disclose the recited feature of a maximum thickness of 1.5 inches. By this deficiency alone the references of record fail to support a *prima facie* case of obviousness.

In addition, as previously noted, Entrop and Casteel function in completely different ways and there is no teaching or suggestion in either reference (or anywhere else) that explains how one would modify Entrop so that it would work with a maximum thickness of 1.5 inches. As previously noted, it does appear possible to modify Entrop to provide this recited feature. The Final Office Action has failed to address this point and has merely provide conclusory remarks about how the two references could be combined without any persuasive reasoning for why this is so. Thus, the Office Action fails to provide any real support for how or why a person of skill in the art would be motivated to modify Entrop based on the teaching of Casteel. As explained in *Dystar Textilfarben GMBH & Co. Deutschland KG. v. C.H. Patrick Co.*; __ F.3d __, 2006 WL 2806466 at *10 (Fed. Cir. 2006), “[c]onclusory statements such as those here provided do not fulfill the agency’s obligation’ to explain all material facts relating to a motivation to combine.”

In response to the comments provided in the Advisory Action, Applicant respectfully submits that the number of allowed claimed directed toward a range of values makes it plain that

a claim can directed to a range of values and more than amply counters this suggestion. Furthermore, here the claimed light fixture is much more than a mere arbitrary reduction in size and functions in a different manner than Entrop, which as Applicant has previously explained, does not appear capable of being modified to have a maximum thickness of 1.5 inches. Indeed, as the Advisory Action admits, the Casteel reference provides support for the existence of a long-felt need, something which Casteel could not meet. Thus, as previously noted, Casteel actually provides further support for the nonobviousness of the subject matter of claim 23. In view of the above, this ground of rejection should be withdrawn.

Claims 24-28 depend from claim 23 and are not obvious in view of the cited reference for at least the above reasons and for the additional features recited therein.

Accordingly, withdrawal of this ground of rejection is respectfully requested.

Rejection under 35 U.S.C. § 103(a) – Entrop & Yonkers

Claims 3, 6-7, 10, 16, and 18-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Entrop in view of Yonkers. These claims, however, depend from independent claim 1, and, as discussed above, Entrop fails to disclose, suggest or teach all the limitations of claim 1. The Office Action has not suggested that Yonkers corrects the above noted deficiencies in Entrop, nor does Yonkers appear to be able to do so. Accordingly, the combination of Entrop and Yonkers fails to support a *prima facie* case of obviousness with respect to claim 1.

In addition, Applicants note that Entrop and Yonkers operate in substantially different ways and it does not seem possible to modify Entrop with the teachings of Yonkers. For example, the Final Office Action has provided no support for how the reflectors 1, 6 and 7 could be modified so as to work when shaped to provide the features recited in claim 3. It appears that such a modification would prevent Entrop from providing the desired functionality. Furthermore, while Entrop fails to disclose an inner aperture in the first place, as noted above, if the reflector 6 were modified to provide a truncated diamond shape than the light from reflector 7 could not reach the reflector 1 and Entrop would no longer function as intended. Applicant notes that given the different manner in which the two references work, a person of skill in the art would not be motivated to modify Entrop in view of Yonkers because such modification would prevent the reflectors 1, 6, 7 from working as intended. In addition, neither reference

Serial No.: 10/781,539
RCE filed October 19, 2006
Response and RCE to Final Office Action mailed May 19, 2006

provides any suggestion or teaching of how the reflectors of Entrop could be modified based on the teachings of Yonkers. If the Examiner disagrees with this point, Applicant respectfully request a more detailed and supported explanation of how Entrop would work with the reflector 1, 6 and 7 modified to show the recited features each of claims 3, 6-7, 10, 16, and 18-19 because the current reasoning fails to provide sufficient support for this combination and does not address the fact that Entrop would no longer function as intended if so modified. Otherwise, as the two references cannot be properly combined, they do not support a *prima facie* case of obviousness with respect to claims 3, 6-7, 10, 16, and 18-19.

Accordingly, withdrawal of this ground of rejection is respectfully requested.

CONCLUSION

As all rejections have been addressed, Applicant respectfully requests reconsideration of the application and allowance of all pending claims.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: October 19, 2006

By: /Stephen L. Sheldon/

Stephen L. Sheldon
Registration No. 58,732

Banner & Witcoff, LTD.
Ten South Wacker Drive
Chicago, Illinois 60606
Tel: (312) 463-5000
Fax: (312) 463-5001